

**Remarks/Arguments:**

Favorable reconsideration of this application, in light of the present amendments and following discussion, is respectfully requested.

Claims 1-3, 5-10, and <sup>12</sup>13-16 are pending; Claims 4 and <sup>11</sup>8 are cancelled; and Claims 1-2 and <sup>9</sup>8 are amended. Claims 6, 7, and 14-16 are withdrawn from consideration. As the amendment to Claims 1 and 8 incorporates the features previously recited in Claims 4 and 11, respectively, as well as features supported in the specification at page 18, lines 16-21, for example, it is respectfully submitted that no new matter is added by this amendment.

In the outstanding Office Action, Claims 1-5 and 8-13 were rejected under 35 U.S.C. § 112, first paragraph; Claims 8-10 and 12 were rejected under 35 U.S.C. § 103(a) as anticipated by Kawata et al. (U.S. Pat. No. 5,662,962, hereafter Kawata); Claims 1-5 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kawata in view of Hieda et al. (U.S. Pat. No. 6,398,900, hereafter Hieda); Claim 11 was rejected under 35 U.S.C. § 103(a) as unpatentable over Kawata and further in view of Anzaki et al. (U.S. Pat. No. 6,316,110, hereafter Anzaki); Claim 13 was rejected under 35 U.S.C. § 103(a) as unpatentable over Kawata and further in view of Murata et al. (U.S. Pat. No. 5,886,819, hereafter Murata); Claims 1-3 and 5 were rejected under 35 U.S.C. § 103(a) as unpatentable over Masahito et al. (JP Pub. No. 08-1990962, hereafter Masahito); Claim 4 was rejected under 35 U.S.C. § 103(a) as unpatentable over Masahito in view of Hieda and further in view of Anzaki; Claim 11 was rejected under 35 U.S.C. § 103(a) as unpatentable over Masahito and further in view of Anzaki; and Claim 13 was rejected under 35 U.S.C. § 103(a) as unpatentable over Masahito and further in view of Murata.

With regard to the rejection of Claims 1-5 and 8-13 under 35 U.S.C. § 112, first paragraph, that rejection is traversed. The Office Action states at page 2 that one of ordinary skill in the art would not have been able to understand that the Applicants were claiming

surface resistivity. However, in the Office Action dated August 6, 2002, at page 3, paragraph 5, it was indicated that surface resistivity is conventionally written in  $\Omega/\square$  physical units. Accordingly, as the outstanding Office Action of August 6, 2002, was able to determine that the Applicants were referring to surface resistivity, it is respectfully submitted that the Applicants' invention was clear to one of ordinary skill in the art,<sup>1</sup> and that the present rejection under 35 U.S.C. § 112, first paragraph, is improper. It is therefore respectfully requested that this rejection be withdrawn.

Regarding the rejection of Claims 8-10 and 12 under 35 U.S.C. § 103(a) anticipated by Kawata, that rejection is respectfully traversed.

Claim 8, as amended, recites in part: "wherein the conductive layer is overlaid with an anchor coating layer and a hard coating layer in that order, and wherein the hard coating layer is selected from among a silicone-based hard coating layer and a UV curable hard coating layer."

Kawata relates to a transparent electroconductive substrate and method for forming the same. Kawata describes that a transparent, electroconductive ink having therein ultrafine ITO particles dispersed in a solvent or in a solvent containing a resin dissolved therein is coated and dried on a transparent support, then dried and optionally baked, and thereafter an overcoating liquid consisting essentially of silica sol is coated over the resulting transparent, electroconductive film formed on the support.<sup>2</sup> However, what Kawata fails to disclose or suggest is that the hard coating layer selected from among a silicone-based hard coating layer and a UV curable hard coating layer.

Accordingly, as Kawata fails to disclose or suggest the limitations recited in Claim 8, from which Claims 9, 10, and 12 depend, it is respectfully submitted that Claims 8-10 and 12

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<sup>1</sup> See also, Passi, "Surface Resistance or Surface Resistivity," (previously of record).

<sup>2</sup> Kawata, abstract.

patentably distinguish over Kawata. It is therefore respectfully requested that this rejection be withdrawn.

With regard to the rejection of Claims 8-10 and 12 under 35 U.S.C. § 102(b) as anticipated by Masahito, that rejection is also traversed.

As noted above, Claim 8 recites that the conductive layer is overlaid with an anchor coating layer and a hard coating layer in that order, and that the hard coating layer is selected from among a silicone-based hard coating layer and a UV curable hard coating layer.

Masahito relates to a conductive film-forming composition. However, like Kawata, Masahito fails to disclose or suggest that the hard coating layer is selected from among a silicone-based hard coating layer and a UV curable hard coating layer.

Accordingly, it is respectfully submitted that Claim 8 patentably distinguishes over Masahito. Likewise, it is respectfully submitted that dependent Claims 9, 10, and 12 patentably distinguish over Masahito for the reasons above set forth with regard to Claim 8, and it is respectfully requested that this rejection be withdrawn.

Regarding the rejection of Claims 1-5 under 35 U.S.C. § 103(a) as unpatentable over Kawata in view of Hieda, that rejection is also traversed.

Claim 1 recites in part: “wherein the conducting layer is overlaid with a hard coating layer selected from among a silicone-based hard coating layer and a UV curable hard coating layer.”

As noted above, Kawata fails to disclose or suggest a hard coating layer selected from among a silicone-based hard coating layer and a UV curable hard coating layer. It is respectfully submitted that Hieda fails to remedy this defect of Kawata.

Hieda relates to a method of sticking a transparent electromagnetic wave shield film onto a front surface of a plasma display panel. However, like Kawata, Hieda fails to disclose

or suggest a hard coating layer selected from among a silicone-based hard coating layer and a UV curable hard coating layer.

Accordingly, as neither Kawata nor Hieda, either alone or in combination, discloses or suggests the limitations recited in Claim 1, it is respectfully submitted that Claim 1 patentably distinguishes over the applied combination of Kawata and Hieda. Likewise, dependent Claims 2, 3, and 5, which depend from Claim 1, are considered to patentably distinguish over the applied combination of Kawata and Hieda for the reasons set forth with regard to Claim 1. It is therefore respectfully requested that this rejection be withdrawn.

Regarding the rejection of Claim 11 under 35 U.S.C. § 103(a) as unpatentable over Kawata in view of Anzaki, that rejection is also traversed.

Claim 11 has been cancelled and the subject matter thereof has been incorporated into Claim 8. Claim 8 recites that the conductive layer is overlaid with a hard coating layer, and the hard coating layer is selected from among a silicone-based hard coating layer and a UV curable hard coating layer.

As earlier noted, Kawata fails to disclose or suggest this feature. It is respectfully submitted that Anzaki fails to remedy the above-noted defects of Kawata.

Anzaki relates to an electromagnetic wave filter for plasma display panels. Kawata describes that the electromagnetic shield film is a seven-layered laminate in which a dielectric layer and a metal layer containing silver as the principle ingredient are laminated alternately with a dielectric layer being the first to be provided on the transparent substrate.<sup>3</sup> However, Anzaki fails to disclose or suggest that a hard coating layer is selected from among a silicone-based hard coating layer and a UV curable hard coating layer.

As neither Kawata nor Anzaki, either alone or as applied in combination, discloses or suggests the features recited in Claim 8, it is respectfully submitted that dependent Claim 11

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<sup>3</sup> Anzaki, Abstract.

patentably distinguishes over the applied combination of Kawata and Anzaki. It is therefore respectfully requested that this rejection be withdrawn.

As for the rejection of Claim 13 under 35 U.S.C. § 103(a) as unpatentable over Kawata in view of Murata, that rejection is also traversed.

Claim 13 depends from Claim 8, which recites that the hard coating layer is selected from among a silicone-based hard coating layer and a UV curable hard coating layer.

As earlier noted, Kawata fails to disclose or suggest this feature, and it is respectfully submitted that Murata does not remedy the identified deficiencies of Kawata.

Murata relates to an antiglare material and polarizing film. Murata describes that the polarizing film is a laminate consisting of a first protective layer which is an antiglare material and a second protective layer laminated onto the unroughened surface of the first protective layer.<sup>4</sup> However, Murata fails to disclose or suggest a hard coating layer selected from among a silicone-based hard coating layer and a UV curable hard coating layer.

Accordingly, as neither Kawata nor Murata, either alone or in combination, discloses or suggests the hard coating layer recited in Claim 8, it is respectfully submitted that Claim 13 patentably distinguishes over the applied combination of Kawata and Murata. It is therefore respectfully requested that this rejection be withdrawn.

Regarding the rejection of Claims 1-3 and 5 under 35 U.S.C. § 103(a) as unpatentable over Masahito in view of Hieda, that rejection is also traversed.

As noted above, neither Masahito nor Hieda discloses or suggests a hard coating layer selected from among a silicone-based hard coating layer and a UV curable hard coating layer. Accordingly, it is respectfully submitted that Claims 1-3 and 5 patentably distinguish over the applied combination of Masahito and Hieda, and it is respectfully requested that this rejection be withdrawn.

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<sup>4</sup> Murata, Abstract.

With regard to the rejection of Claim 4 under 35 U.S.C. § 103(a) as unpatentable over Masahito in view of Hieda and further in view of Anzaki, that rejection is traversed. The subject matter of Claim 4 has been incorporated into Claim 1, and Claim 4 has been cancelled.

As earlier noted, none of Masahito, Hieda or Anzaki discloses or suggests a hard coating layer selected from among a silicone-based hard coating layer and a UV curable hard coating layer, as recited in Claim 1. It is therefore respectfully submitted that Claim 1 patentably distinguishes over Masahito, Hieda, and Anzaki, either alone or in combination.

With regard to the rejection of Claim 11 under 35 U.S.C. § 103(a) as unpatentable over Masahito in view of Anzaki, that rejection is traversed. The subject matter of Claim 11 has been incorporated into Claim 8.

As noted above, neither Masahito nor Anzaki, either alone or in combination, discloses or suggests a hard coating layer selected from among a silicone-based hard coating layer and a UV curable hard coating layer. It is therefore respectfully submitted that Claim 8 patentably distinguishes over the applied combination of Masahito and Anzaki.

Regarding the rejection of Claim 13 under 35 U.S.C. § 103(a) as unpatentable over Masahito in view of Murata, that rejection is also traversed. Claim 13 depends from Claim 8.

As noted above, neither Masahito nor Murata, either alone or in combination, discloses or suggests that a hard coating layer is selected from among a silicone-based hard coating layer and a UV curable hard coating layer, as recited in Claim 8. Therefore, it is respectfully submitted that Claim 13 patentably distinguishes over the applied combination of Masahito and Murata, and it is respectfully requested that this rejection be withdrawn.

Consequently, in view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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